

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN SCHADE, AXEL SANNER, HANS-ULRICH WEKEL,
FRANZ FROSCH, AND HORST WESTENFELDER

Appeal No. 1998-3248
Application No. 08/325,219

ON BRIEF

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before PAK, WARREN and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 10-15 and 17, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a cosmetic or pharmaceutical composition including a specified copolymer as a thickener or dispersant. According to appellants (specification, page 6, lines 12-16), a wide variety of cosmetic applications are

contemplated to be within the scope of the invention such as compositions including creams, lotions or gels. The copolymer is alleged to be suitable for its thickening properties, for example, in aqueous systems (specification, page 6, lines 16-25). In responding to the examiner's new ground of rejection as set forth in the answer, which rejection is now before us for review, appellants did not present separate arguments in favor of patentability for each of the appealed claims. Consequently, all of the appealed claims are appropriately treated as a single grouping and stand or fall together on this record. We select claim 10 as the representative claim on which we shall decide this appeal. Claim 10 is reproduced below.

10. A cosmetic or pharmaceutical composition containing as a thickener or dispersant an effective amount of a copolymer obtained by free-radical polymerization of
A) 50-99.9% by weight of an olefinically unsaturated C₃-C₅-monocarboxylic acid, of an olefinically unsaturated C₄-C₈-dicarboxylic acid or of its anhydride or a mixture of such carboxylic acids or anhydrides with
B) 0.1-50% by weight of one or more long-chain compounds with isolated C-C multiple bonds selected from the group consisting of

- (1) mono- or polyunsaturated C₈-C₃₀-monocarboxylic acids which may have additional hydroxyl groups, as well as their alkali metal and alkaline earth metal salts, alkyl esters, amides, sorbitan esters, glycerol esters or polyglycerol esters,
- (2) mono- or polyunsaturated aliphatic C₈-C₃₀ amines,
- (3) mono- or polyunsaturated C₈-C₃₀-alcohols as well as their esters with saturated C₁-C₄-monocarboxylic acids,

- ¹ This new ground of rejection was set forth in item No. 12 of the answer. Separate rejections of appealed claims under 35 U.S.C. § 102(b) over George and over Blank as set forth in the final rejection and under 35 U.S.C. § 112, second paragraph as set forth in a supplemental answer mailed July 10, 1997 were withdrawn by the examiner. See item No. 11 of the answer and page 2 of a supplemental answer mailed October 09, 1997.

examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's § 103 rejection for substantially the reasons set forth in the answer and supplemental answers. We add the following for emphasis.

Representative claim 10 calls for a cosmetic or pharmaceutical composition containing a thickening or dispersant effective amount of a copolymer obtained by free radical polymerization of at least two components (A and B).² Because appellants' representative claim 10 describes a product in terms of the process for making same, this claim is in product-by-process form. Thus, the patentability of the claimed invention is determined based on the product itself, not on the method of making it. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process."). Whether a rejection is under

² Components C and D, as listed in representative claim 10, may not be present as reactants for making the claimed copolymer as made evident by the 0 weight percent lower limit for those components that is specified in claim 10.

35 U.S.C. § 102 or § 103, when appellants' product and that of the prior art appear to be identical or substantially identical, the burden shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of appellants' claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See *Best*, 562 F.2d at 1255, 195 USPQ at 434; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Appellants' copolymer is made from a reactant component A, which is present in a 50-99.9 weight percent amount and may be selected from among several acids or anhydrides as generically described in claim 10. Appellants mention acrylic acid as one of several particularly suitable acids that is within the scope of the generically described acids from which component A may be selected. See page 3, lines 18-20 of appellants' specification.

Appellants' reactant component B is present in a 0.1-50 weight percent amount and may be selected from among several generically described monomers or compounds. Respecting

component B, appellants (specification, page 4, lines 37-41) list terminal C₁₆-C₂₄ alkenes such as 1- octadecene (an alpha olefin), as particularly suitable selections that are within the scope of representative claim 10. Since no particular cosmetic or pharmaceutical is called for in claim 10, the representative claimed subject matter includes any composition having cosmetic or pharmaceutical activity that contains an effective amount of copolymer product of the free-radical polymerization process recited in claim 10.

Similar to appellants, George (page 2, lines 19-25) discloses a copolymer obtained from a monomer mixture including 65-90 weight percent acrylic acid and 10-35 weight percent of an alpha-olefin having 6-18 carbon atoms, such as octadecene. George (page 2, lines 30-33, page 12, lines 13-17 and page 13, lines 2-8) teaches that the copolymer may be made by a free radical catalytic polymerization method, that the copolymer has utility in personal care products and that the product copolymer has thickening properties in an aqueous medium. Accordingly, we agree with the examiner's determination that George describes a copolymer product corresponding to the copolymer product specified in representative claim 10 and reasonably suggests the use of such a copolymer in personal care product compositions,

including cosmetics such as lotions or gels within the scope of representative appealed claim 10. In this regard, the examiner (answer, page 5), in essence, has made the determination that appellants' "[c]osmetic or pharmaceutical compositions are personal care products" within the meaning of the personal care products suggested by George. That finding by the examiner has not been directly and specifically refuted by appellants in the reply briefs.

Rather, appellants' principal contention centers on appellants' view that George differs from the claimed composition in that George does not suggest the copolymer used in their composition. This is so according to appellants since George is concerned with the water absorption and retention properties of the copolymer disclosed therein whereas appellants' copolymer has thickening properties and affects viscosity (reply brief, pages 2-4). However, as pointed out above and in the answer, George not only teaches a copolymer product that corresponds to appellants' copolymer product in the claimed composition, but also teaches a copolymer product that has thickening properties, particularly in aqueous media which would obviously affect viscosity. Hence, the description of the copolymer properties in George is not dissimilar to appellants'

description of their copolymer's thickening properties in aqueous systems. See page 13, lines 6-9 of George and page 6, lines 12-21 of appellants' specification. Moreover, the long chain monomer reactant B used in forming appellants' copolymer includes materials, such as alpha octadecene, which is taught by George, as discussed above. Consequently, appellants' arguments (reply brief, page 3 and supplemental reply brief) implying that component B would attribute hydrophobic properties to appellants' copolymer that George's copolymer would not possess is not persuasive on this record. Thus, we agree with the examiner's determinations that George discloses a copolymer corresponding to that used in appellants' claimed composition and that the overall teachings of George would have led an ordinarily skilled artisan to employ that copolymer as a thickener in a personal care product such as a lotion or gel cosmetic composition. This conclusion is supported by George's disclosure of the thickening properties of that copolymer and the use thereof in personal care products, which an ordinary skilled artisan would reasonably recognize as suggesting personal care cosmetic preparations such as lotions or gels containing such a copolymer as a thickener.

As another point, we note that appellants base no arguments on an allegation of unexpected results for their claimed product. See reply brief, page 4, last four lines.

Under the circumstances recounted above, it is our determination that the evidence of record for and against a conclusion of obviousness, reconsidered in light of the respective arguments advanced by appellants and the examiner, on balance, weighs most heavily in favor of an obviousness conclusion with respect to the rejection under consideration. Accordingly, we shall sustain the examiner's rejection.

CONCLUSION

The decision of the examiner to reject claims 10-15 and 17 under 35 U.S.C. § 103 as being unpatentable over George is affirmed.

AFFIRMED

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